Docket: NECW 18.788 (100806-16753)
Application: 09/897,328

<u>REMARKS</u>

This is in response to the Office Action mailed June 13, 2006.

Claims 1, 3, 6, and 7 have been amended to clarify the operation of the ASP server and to clarify the claims. Specifically, claims 1 and 3 have been amended to recite "said ASP server operated by said examiner". Applicant wishes to note that this amendment does not add new matter as it was previously presented in dependent claim 4, which is cancelled via the current amendment. As such, the Amendment does not require additional search, places the claims in condition for allowance, and/or simplifies issues for appeal. Therefore, it is respectfully requested that the amendments be entered.

Reconsideration of this application is respectfully requested in view of this response/amendment.

<u>STATUS OF CLAIMS</u>

Claims 1-3 and 5-16 are pending.

Claims 1-3 and 5-16 are rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. 6,154,729 (Cannon), in view of U.S. 2001/0047326 (Broadbent).

<u>OVERVIEW OF CLAIMED INVENTION</u>

The present invention, in a non-limiting example, teaches an examination method comprising the steps of: storing information on business activities of an enterprise on an ASP (Application Service Provider) server from a terminal of said enterprise through a network;

providing said information on business activities of said enterprise accumulated on said ASP server for an examiner, said ASP server operated by said examiner; and evaluating activities of said enterprise based on said information on business activities provided for said examiner.

REJECTIONS UNDER 35 U.S.C. § 103

Claims 1-3 and 5-16 are rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. 6,154,729 (Cannon), in view of U.S. 2001/0047326 (Broadbent). To be properly rejected under 35 U.S.C. § 103(a), each and every element of the claims must be addressed through known prior art or be recognized as an obvious variation thereof. Applicant contends that the above mentioned specific combination of Cannon and Broadbent fails to teach many of the features of Applicant's rejected claims.

Cannon apparently discloses a method of compiling merchant information periodically into reports, wherein such reports are then routed to a web server. Such reports can be accessed via the Internet according to varying levels of access (e.g., business level, bank level, or agent level) defined by the merchant.

On page 4 of the Office Action of 06/13/2006, the Examiner contends that column 2, lines 46-60 and column 3, lines 4-11 teach the feature of "said ASP server operated by said examiner". Applicant respectfully disagrees with the Examiner contention as neither the citations nor the references in their entirety teach such a feature.

The first citation of column 2, lines 46-60 merely states that a "user at client station 16 can then gain access to the reports from server 14 over a wide area network connection 20" and that the "user enters a user ID and a password and then clicks the submit button 36 to gain access to the reports." The second citation of column 3, lines 4-11 merely teaches varying levels of access (to such reports) that a merchant can set", for example, "Business Level 74, Bank Level 76, and Agent Level 78".

As can be seen from the citation and the entire Cannon reference, financial data is gathered by host 12, associated with the merchant-side, over pre-determined time-period and the gathered data is consolidated into a report which is sent over a network to a web server 14. Host 12, associated with the merchant-side, is also able to set varying level of access to such reports.

Absent from the Examiner's citations and the entire Cannon reference is an explicit or implicit teaching for a server operated by an examiner. Web server 14 of Cannon is NOT controlled by an examiner (such as, but not limited to, a financial institution), but is rather used by Host 12 to post reports and is also used by Host 12 to set the level of access for various entities, including banking institution.

In stark contrast, Applicant's claims recite the feature of an Application Service Provider (ASP) server storing information on business activities of an enterprise, but controlled by an Examiner (such as, but not limited to, a financial institution). Cannon fails to teach or suggest such a feature. Absent such a showing, Applicant's independent claims 1, 3, 6, 7, 8, 9, 10, 11, 12, and 13 cannot be anticipated or rendered obvious by Cannon.

If the Examiner still feels that Server 14 of the Cannon reference is controlled by a financial institution or client station 16, the Examiner is applicants respectfully remind the examiner that it is the duty of the examiner to specifically point out each and every limitation of a claim being rejected as per §1.104(c)(2) of Title 37 of the Code of Federal Regulations and section 707 of the M.P.E.P., which explicitly states that "the particular part relied on must be designated" and "the pertinence of each reference, if not apparent, must be clearly explained and each rejected claim specified".

Broadbent teaches a computer-implemented method for generation of a set of required procedures for processing a mortgage loan using an Internet based system having a client loan origination system electronically coupled to an automatic compliance engine.

However, Broadbent fails to remedy Cannon's failure to teach or suggest an Application Service Provider (ASP) server storing information on business activities of an enterprise, but controlled by an Examiner (such as, but not limited to, a financial institution).

Further, the Examiner states on page 3 of the Office Action of 06/13/2006 that "the motivation would be that ASP servers are a popular business model with regards to servers and communication systems". However, as mentioned previously, obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so, and wherein such teaching, suggestion, or motivation is found either explicitly or implicitly in the references

themselves or in the knowledge generally available to one of ordinary skill in the art. (see MPEP 2143.01).

It appears that the Examiner is relying on the argument that, given the popularity of ASP servers, it should have been obvious to implement an ASP server according to Applicant's claims. However, Applicant respectfully contents that the mere mention of an ASP server does NOT teach or suggest an ASP server storing information on business activities of an enterprise, but controlled by an Examiner (such as, but not limited to, a financial institution). Absent such a showing, Applicant's claims can neither be anticipated nor rendered obvious by the art of record.

Hence, Applicant respectfully submits that independent claims 1, 3, 6, 7, 8, 9, 10, 11, 12, and 13 cannot be anticipated or rendered obvious by the combination of Cannon and Broadbent references. Applicant respectfully requests the Examiner to withdraw the 35 U.S.C. §103 rejection with respect to independent claims 1, 3, 6, 7, 8, 9, 10, 11, 12, and 13, and further requests allowance thereof. The above-mentioned arguments substantially apply to dependent claims 2, 5, and 14-16 as they inherit all the features of the claim from which they depend. Hence, Applicant respectfully request allowance of claims 2, 5, and 14-16 as they depend from an allowable claim.

SUMMARY

As has been detailed above, none of the references, cited or applied, provide for the specific claimed details of applicant's presently claimed invention, nor renders them obvious. It

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is believed that this case is in condition for allowance and reconsideration thereof and early

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issuance is respectfully requested.
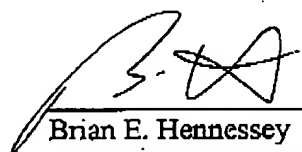
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As this response/amendment has been timely filed, no request for extension of time or

associated fee is required. However, the Commissioner is hereby authorized to charge any

deficiencies in the fees provided to Deposit Account No. 50-1290.

If it is felt that an interview would expedite prosecution of this application, please do not

hesitate to contact applicant's representative at the below number.

Respectfully submitted,

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